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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,770	01/08/2002	Yi Hu	LEX-0294-USA	3157

7590

08/07/2003

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EXAMINER

SWOPE, SHERIDAN

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 08/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

10/041,770

Applicant(s)

HU ET AL.

Examiner

Sheridan L. Swope

Art Unit

1652

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 July 0203 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 July 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation page.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-6.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: Notice of References Cited.

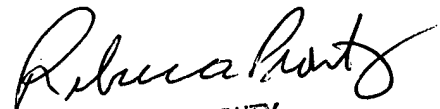
Rejection of Claims 1-6 under 35 U.S.C. 101 because the claimed invention is not supported by a well established utility for either the nucleic acid molecule of SEQ ID NO: 1 or any nucleotide sequence that hybridizes under stringent conditions to SEQ ID NO: 1, or any polynucleotide encoding the amino acid sequence of SEQ ID NO: 2 is maintained. The claimed invention is not supported by an asserted utility based on either a demonstrated function for the protein of SEQ ID NO: 2 or by a deduced function for said protein supported by homology to known proteins.

The only new argument presented by the Applicants in the Request for Reconsideration is found on page 5, the last line to page 7 the third line. Therein Applicants "point out that a sequence sharing 99% identity at the protein level over a large portion of the claimed sequence is present in the leading scientific repository for biological sequence data (GenBank), and has been annotated by third party scientists ... as 'Homo sapiens thrombospondin repeat containing 1 (TSRC1)' (GenBank accession number NM\_019032...)". Applicants further state that "additional third party scientists... have described the full length murine homolog of the human TSRC1 sequence, and this sequence shown an expected 74% identity and 79% similarity at the protein level over the complete length of Applicants' sequence (GenBank accession number AY158701)" and that "Given these two GenBank annotations it is clear that those skilled in the art would clearly believe that Applicants' sequence is a thrombospondin repeat containing protein, specifically the human TSRC1 sequence.

This new argument is not found to be persuasive for the following reasons.

1. Many different types of proteins with different functions and utilities have thrombospondin repeat domains (Adams et al, 2000 Dev Dyn. Jun;218(2):280-99).
2. The human TSRC1 protein of another group has 99% identity with the protein set forth by SEQ ID NO: 2 only over residues 425-857. Since over half of the protein set forth by SEQ ID NO: 2 is not homologous to human TSRC1, Applicant's contention that the function of the protein set forth by SEQ ID NO: 2 can be deduced from its homology to human TSRC1 is in doubt.
3. The function or utility of TSRC1 is unknown (Buchner et al, 2003 Gene 307: 23-30). Therefore, deduction of a function or utility for the protein set forth by SEQ ID NO: 2 based on its homology to TSRC1 is not reasonable.

For these reasons and those described in the prior action, rejection of Claims 1-6 under 35 U.S.C. 101 because the claimed invention is not supported by a well established utility for either the nucleic acid molecule of SEQ ID NO: 1 or any nucleotide sequence encoding the amino acid sequence of SEQ ID NO: 2 is maintained.

  
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1620